IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : **10/598,261**

Applicant(s) : **HENDRICX et al.**

Filed : **8/23/2006**

TC/A.U. : **2889**

Confirmation : **2052**

Examiner : **SNYDER, Zachary J.**

Atty. Docket : **NL040263US1**

Title: **VEHICLE HEADLAMP**

Pre-Appeal Brief Request for Review

Mail Stop **AF**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the final Office action of 10 June 2010, the applicants request review of the final rejection in the above referenced application. No amendments are being filed with this request. This paper is being filed with a notice of appeal.

Claims 1, 4, and 8-10 stand rejected under 35 U.S.C. 112, first paragraph.

Claims 5 and 11-12 stand rejected under 35 U.S.C. 112, second paragraph.

Claims 1-4, 6, 13-15, 17-19, and 21 stand rejected under 35 U.S.C. 102(b) over Dakin et al. (USPA 2003/0102808, hereinafter Dakin).

Claims 1, 5-6, 16, and 20 stand rejected under 35 U.S.C. 102(b) over Jackson et al. (USPA 2002/0185973, hereinafter Jackson).

This review is requested for the reason(s) stated on the attached sheet(s) .

REMARKS

Clear errors in the examiner's rejection(s)

The Examiner asserts that the applicants' specification fails to support the claimed ionizable salt consisting of NaI, TlI, CaI_2 and XI_3, wherein X is selected from the group consisting of rare earth metals and a molar percentage ratio CaI_2/(NaI + TlI + CaI_2 + XI_3) is greater than 45%. This assertion is incorrect.

At page 2, lines 24-29 of the applicants' specification, the applicants disclose:

"In a preferred embodiment of a metal halide lamp in accordance with the invention X is Ce, wherein the molar percentage ratio CeI_3/(NaI+TlI+CaI_2+CeI_3) lies between 0 and 10%, in particular between 0.5 and 7%, more in particular between 1 and 6. Preferably, in a further embodiment with X is Ce, the molar percentage ratio CaI_2/(NaI+TlI+CaI_2+CeI_3) lies ***between 20 and 90%***, in particular ***between 35 and 85%***, more in particular ***between 45 and 80%***."

As is readily apparent, a molar percentage ratio that is between 45 and 80% is a molar percentage ratio that is greater than 45%.

The Examiner also asserts that the applicants' specification fails to support the claimed ionizable salt consisting of NaI, TlI, CaI_2 and XI_3, wherein X is selected from the group consisting of rare earth metals and a molar percentage ratio CaI_2/(NaI + TlI + CaI_2 + XI_3) is less than 90%. This assertion is also incorrect.

As noted above, the specification specifically states that the molar percentage ratio "lies ***between 20 and 90%***". As is readily apparent, a molar percentage ratio that is between 20 and 90% is a molar percentage ratio that is less than 90%.

The Examiner also asserts that the applicants specification fails to support the claimed ionizable salt consisting of NaI, TlI, CaI_2 and XI_3, wherein X is selected from the group consisting of rare earth metals and a molar percentage ratio CaI_2/(NaI + TlI + CaI_2 + XI_3) is less than 80%. This assertion is also incorrect.

As noted above, the specification specifically states that the molar percentage ratio is "***between 45 and 80%***". As is readily apparent, a molar percentage ratio that is between 45 and 80% is a molar percentage ratio that is less than 80%.

Because the applicants' specification clearly contains a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and sets forth the best mode contemplated by the inventor of carrying out the invention, the applicants respectfully maintain that the rejection of claims 1 and 8-10 under 35 U.S.C. 112, first paragraph is unfounded, and should be withdrawn.

The Examiner asserts that the applicants' claims 5 and 11-12 are indefinite with regard to an amount of NaI, TlI, CaI_2 and XI_3 that lies between 0.025 and 0.3 g/cm^3, because "it is unclear whether the volume cm^3 is referring to the interior volume of the discharge vessel or some other volume of the lamp" (Office action, page 3, last line - page 4, first line). This assertion is incorrect.

Claim 1, upon which claims 5 and 11-12 depend, specifically recites "a discharge space filled with a filling comprising an inert gas, and an ionizable salt… said ionizable salt consisting of NaI, TlI, CaI_2 and XI_3". Under conventional patent claim interpretation, a claim to a characteristic of an element is interpreted to be the same element in the parent claim; that is, in this case, the ionizable salt within the discharge space.

Under the conventional interpretation of density, the amount of material is specified with respect to a unit volume in which the material is present; referring to an arbitrary volume that does not contain the material renders such a measure per unit volume meaningless. A claim interpretation that renders a claimed feature meaningless is not permitted if an alternative conventional interpretation is available that provides meaning to the claimed feature. Accordingly, the applicants respectfully maintain that the rejection of claims 5 and 11-12 under 35 U.S.C. 112, second paragraph is unfounded, and should be withdrawn.

The Examiner asserts that Dakin discloses, via the table at [0025][1], a combination of elements such that a molar percentage ratio CaI_2/(NaI + TlI + CaI_2 + XI_3) is greater than 45%. This assertion is incorrect.

The Examiner uses Dakin's combination of CaI_2 = 45%, NaI =45%, TlI = 5%, and XI_3 = 5%. Using this combination, the molar percentage ratio will be equal to 45%, it will not be ***greater*** than 45%, as specifically claimed by the applicants. Accordingly, the applicants respectfully maintain that the rejection of claims 1-4, 6, 13-15, 17-19, and 21 under 35 U.S.C. 102(b) over Dakin is unfounded, and should be withdrawn.

The Examiner asserts that Jackson discloses, at [0060], a combination of elements such that a molar percentage ratio CaI_2/(NaI + TlI + CaI_2 + XI_3) is greater than 45%. This assertion is incorrect.

The Examiner uses Jackson's combination of CaI_2 = 43%, NaI =14%, TlI = 7%, and XI_3 = 36% (X being the combination of rare earth elements Dy, Ho[2], and Tm). Using this combination, the molar percentage ratio will be equal to *43%*, it will not be *greater than 45%*, as specifically claimed by the applicants. Accordingly, the applicants respectfully maintain that the rejection of claims 1, 5-6, 16, and 20 under 35 U.S.C. 102(b) over Jackson is unfounded, and should be withdrawn.

Respectfully submitted,

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[1] The Office action refers to [0024], but [0024] does not contain a table.
[2] The Office action refers to "HoI" at 12%; Jackson teaches HoI_3 at 12%.